

-2-

Remarks

Claims 1-18 are pending in the application.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-18 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent No. 63-154781 to Hoescht. The Examiner states that Hoescht discloses the following elements: 1) a base substrate; 2) a binder resin, such as acrylate, and a tackifier; and 3) a plasticizer compatible with the tackifier "wherein the thus formed assembly . . . is heated and applied/adhered to a second substrate layer."

For anticipation under 35 U.S.C. § 102(b), the reference must teach every element of the claimed invention either explicitly or impliedly. MPEP 706.02; MPEP 2131.01. The Hoescht reference fails to teach a pressure sensitive adhesive. Irrespective of heat, the adhesive in Hoescht is not a pressure sensitive adhesive, i.e., "a viscoelastic material that possesses the following properties: 1) permanent and aggressive tack, 2) adherence with no more than finger pressure, 3) sufficient ability to hold onto a substrate, and 4) sufficient cohesiveness strength to be removed cleanly from a substrate." See Applicants' Specification, at page 3, lines 3-7.

Hoescht discloses a heat sensitive adhesive material in which "conventional release paper is unnecessary, due to the high blocking resistance" until the application of heat. Blocking is defined as "adhesion between touching layers of similar or dissimilar materials such as that which occurs under moderate pressure or during storage." See *Handbook of Adhesives*, p. 94 (2d Ed. 1977). As further described on page 7 of Hoescht, paragraphs 3 and 4, the material is "not blocked" and thus can be freely wound or stacked, i.e., non-tacky.

Hoescht defines its "heat sensitive material" on page 3, paragraph 3 as:

Regarding the term heat sensitive material used according to the present invention, it is used as a general term for adhesive sheets, adhesive tape, adhesive plates, etc., adhesive materials where there is no blocking at room temperature and where by heating a semi-permanent adhesive surface is achieved.

Heat-activated adhesives provide a very high, irreversible bond, and need heat for application. See *Handbook of Adhesives*, p. 726. Pressure sensitive adhesives only require light pressure to adhere.

The Hoescht reference suggests that the "semi-permanent adhesive surface" should be applied to the surface for adhesion in conjunction with the heat-activating

-3-

step, or soon thereafter (page 7, paragraph 4). This describes a laminating, hot melt type of adhesive which only demonstrates tackiness when heated. When contacted with a substrate, the Hoescht adhesive forms a semi-permanent bond in which peel off (or separation) is prevented because the plasticizer does not recrystallize. Pressure sensitive adhesives can be removed cleanly from a substrate. See *Handbook of Adhesives*, p. 726.

The Hoescht reference fails to teach or suggest a pressure sensitive adhesive, as provided in Claim 1 of Applicants' Specification. Thus, the Hoescht reference fails to anticipate the present invention. Applicants request that the rejections under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

In view of the arguments offered herein, Applicants respectfully submit that the Examiner's grounds for objection and rejection are overcome and respectfully solicit reconsideration and withdrawal of the rejections to place the application in condition for allowance.

Respectfully submitted,

Nancy M. Lambert

Nancy M. Lambert
Registration No. 44,856
Attorney for Applicants

NML:jlh/56117US002 Amend to OA 6-10-03
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427
(651) 733-2180
Facsimile: (651) 736-3833

Dated: September 10, 2003

RECEIVED
CENTRAL FAX CENTER
SEP 11 2003

OFFICIAL